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In re Application of NEUHAUS et al
U.S. Application No.: 09/674,768
Int. Application No.: PCT/EP99/03292
Int. Filing Date: 12 May 1999
Priority Date: 13 May 1998

Attorney Docket No.: 0147-0215P
For: TRANSGENIC PLANTS WITH A MODIFIED
ACTIVITY OF A PLASTIDIAL ADP/ATP
TRANSLOCATOR

DECISION

This is in response to applicants' "Renewed Petition Under 37 CFR 1.497(d)" filed 03 April 2002.

BACKGROUND

On 12 May 1999, applicants filed international application PCT/EP99/03292, which claimed priority of an earlier Germany application filed 13 May 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 18 November 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 November 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 November 2000.

On 06 November 2000, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 16 January 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 23 February 2001, applicants filed an executed declaration.

On 28 March 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), which indicated that the declaration filed 23 February 2001 does not identify all of the inventors that are listed on the international application.

On 04 January 2002, applicants filed a petition under 37 CFR 1.497(d) along with statements from two individuals who request to be deleted as inventors.

On 25 January 2002, this Office mailed a decision dismissing the 04 January 2002 petition on grounds that applicants had not adequately provided written consent of the assignee.

On 03 April 2002, applicants filed the present renewed petition along with a newly executed assignment agreement and a statement from the assignee.

DISCUSSION

A review of the application file indicates that Jozef Schell and Norbert Martini are listed as joint inventors on the international application but are not listed in the declaration filed 23 February 2001.

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Applicants have previously satisfied items (1) and (2) above.

With regard to item (3) above, in situations where an assignee consents to a correction of inventorship, ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b), ownership is established by documentary evidence of a chain of title from the original owner to the assignee. Applicants have submitted assignment agreements which establish a chain of title from inventors Ekkehard Neuhaus, Torsten Moehlmann, and Karl-Heinz Graeve-Kampfenkel to the assignee. However, applicants have not submitted an acceptable assignment agreement with respect to inventor Joachim Tjaden. The assignment agreement filed with the present renewed petition is unacceptable because the list of inventors is incorrect. Therefore, the assignee has not established ownership of the application.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time are available pursuant to 37 CFR 1.136.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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